

REMARKS/ARGUMENTS

Claims 23, 25-29 and 31-43 are pending in the application.

Allowable Subject Matter

Claims 26, 29, and 38 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Rewriting of these claims in independent form has been effected by the present amendment.

Claim Rejection - 35 USC § 103

Claims 22-25, 27-28, 31-37, and 39-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizumo (“Mizumo”), U.S. Publication No. US 2001/0021311 A1, in view of Brookes et al. (Brookes), U.S. Publication No. US 2003/0014295 A1. The rejection is traversed, and the Examiner is invited to reconsider them in light of the following comments.

Applicants respectfully believe that the Examiner has overlooked an important claimed aspect of the present invention. Before getting into the specific language of the claims, Applicants think that a brief explanation of the intent of the claims using specific real-world examples of an exemplary embodiment would be helpful.

By way of explanation, assume that a photographer (user) desires prints of photos stored on a memory card (digital storage device). In the example, the memory card is sold the Eastman Kodak Company, for example, and contains a stored “code” identifying Kodak as the “business entity” associated with the memory card. Having a plurality of retail stores to choose from, let’s assume that the store selected has a Kodak Kiosk (order terminal) connected through a “network service” to a plurality of photofinishing labs (service providers).

Now, according to a feature of the claimed invention, the business entities (Kodak being one in the example) each have predefined business relationships with each service lab (say, Ofoto). The predetermined business relationships may provide discounts to users who use memory cards with codes identifying one business entity, and different discount levels to users who use memory cards with codes identifying other business entities. A particular service provider may offer special

services to users of a particular model of camera cell phone that are not offered to users of cell phones from other business entities.

A close review of the rejected claims will show that the claims are directed to such business relationships between business entities associated with storage devices and service providers. This claimed relationship is not disclosed in the references of record.

The Office Action cites Brookes for its teaching of a database of service providers from which a ranking can be provided such as by price, criteria, customer satisfaction, etc. However, Brookes fails to disclose any relationship between the service providers and a business entity. Assuming *arguendo* that the Brookes and Mizumo might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. Applicants claims include the relationship feature. The primary reference fails to disclose such a relationship and the secondary reference fails to disclose the information undisclosed by the primary reference.

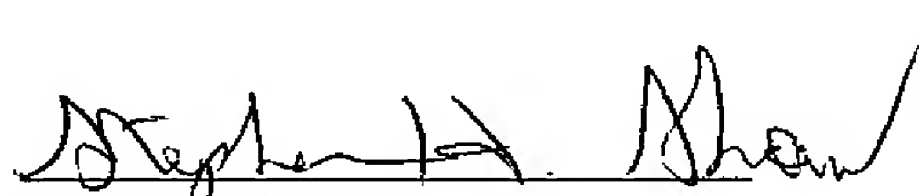
To establish *prima facie* obviousness, all the claim limitations must be taught or suggested by the prior art. *See* MPEP 2143.03. It is well established in the law that, for a proper *prima facie* rejection of a claimed invention on the basis of obviousness under 35 U.S.C. § 103, the references relied upon must teach every element of the claimed invention. "Each element of a claim is material." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985).

Summary

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company, Deposit Account No. 05-0225.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stephen H. Shaw", is written over a horizontal line.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.